

### Remarks

The Advisory Action mailed June 22, 2010, has been carefully considered. After such consideration, independent Claims 1; 12 and 26, and dependent Claim 27, have been amended to further clarify the present inventions. Accordingly, Claims 1-3 and 5-11; 12-18, 20 and 25; and 26-27, 29-41, 43 and 48 remain in the case with none of the claims currently being allowed.

With respect to the previous rejection of Claims 1-3, 5-18, 20, 25-27, 29-41, 43 and 48 under 35 USC §103(a) as unpatentable over Gebhardt in view of Mulford and ASTM E119-95a (the “Omega Point” reference provided by Applicants), Applicants again submit that obviousness requires:

- 1) Motivation to combine;<sup>1</sup>
- 2) Prior art elements that are capable of being combined;<sup>2</sup> and
- 3) A resulting combination that would have worked for its intended purpose.<sup>3</sup>

For at least the reasons articulated in its September 22, 2010 response, Applicants respectfully assert that the combination of references cited by the Office does not meet this threshold. Specifically, since Gebhardt’s structure is structurally sound without the party walls, there would be no reason to employ load-bearing party walls of the Mulford and Omega Point combination. Thus, there is **no motivation to combine**.

In addition, the separation walls of the present inventions are not separate structures that could be picked up and moved. Accordingly, Mulford and Omega Point are **not capable of being combined** with Gebhardt, which has slide-in walls.

Finally, one could not use the Mulford/Omega Point separation walls in Gebhardt’s structure because Gebhardt’s requires walls that disengage and one would not choose to use disengaging support walls, especially in a fire. As such, the combination of Mulford, Omega Point and Gebhardt **would not work for the intended purpose**.

---

<sup>1</sup> *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)

<sup>2</sup> See discussion of *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-40 (2007) in *DuPuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 131, 14-15 (Fed. Cir. 2009).

<sup>3</sup> *Id.*

Although Applicants believe that the rejections of record are not proper, preliminary amendments have been made to the claims in an effort to expedite prosecution. The basis in the originally filed specification for such amendments are as follows:

- Addition of "...2X8 wood..." found on page 4, line 15.
- Addition of "...having an overlaid double top plate..." found on page 4, lines 15-16.
- Addition of "...said area separation wall having a maximum height of 10 feet..." found on page 4, lines 18-19.
- Addition of "...a second area separation wall constructed substantially identically to said first area separation wall, said second area separation wall connected to said first area separation wall..." also found on page 4, lines 18-19.

Accordingly, no new matter has been introduced.

For at least the reasons discussed above, Applicants respectfully request that the Office's rejections should be withdrawn, and the claims should be allowed. However, if Applicants' attorney can assist in resolving any issue, the opportunity for a telephone interview would be welcomed.

Respectfully submitted,



Edward W. Rilee  
Registration No. 31,869  
MacCord Mason PLLC  
P.O. Box 2974  
Greensboro, NC 27402  
(336) 273-4422

Date: October 22, 2010  
File No.: 8274-020